

REMARKS

Claims 1-28 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, the Examiner rejected claims 1-6 and 12-16 under 35 U.S.C. § 102(e), as being anticipated by PCT publication WO 02/30401 by Microchips, Inc. (hereinafter referred to as “the Microchips, Inc. ‘401 publication”).

In the outstanding Office Action, the Examiner rejected claims 7-11 and 17-28 under 35 U.S.C. § 103(a), as being unpatentable over the Microchips, Inc. ‘401 publication in view of U.S. Patent No. 6,293,923 to Yachia et al. (hereinafter referred to as “the Yachia et al. ‘923 patent”).

By this Response and Amendment, claims 1-28 remain unchanged.

Claim Rejections under 35 U.S.C. § 102(e)

The Examiner rejected claims 1-6 and 12-16 under 35 U.S.C. § 102(e), as being anticipated by the Microchips, Inc. ‘401 publication.

Response

Applicants respectfully traverse the rejections since all of the features of the presently claimed subject matter are not disclosed by the cited reference.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

The abstract of the Microchips, Inc. ‘401 publication discloses “[M]ethods and devices are provided for enhancing corrosion of an electrode in a biocompatible fluid. The method comprises (1) placing a primary electrode and a counter electrode in an electroconductive biocompatible fluid to form an electrochemical cell; and (2) applying a time-varying potential, through the electrochemical cell, to the primary electrode. In a preferred embodiment, the

primary electrode is metal and comprises a reservoir cap of a microchip device for the release of molecules or exposure of device reservoir contents. The potential preferably is characterized by a waveform having a maximum potential effectively anodic to meet or exceed the corrosion potential of the primary electrode. Also, the minimum potential preferably is effectively cathodic to be below the value where redeposition of metal ions on the metal electrode can substantially occur, thereby corroding the metal electrode.”

Original independent claim 1 of the instant application recites: “A medical device for controlled release of one or more substances into a body cavity containing an electrolytic fluid comprising: (a) a power supply having first and second terminals; (b) a plurality of blister-like vesicles mounted on a first surface, each vesicle having at least a metallic portion formed from a first metal; (c) for each vesicle, an electrical connection between the metallic portion of the vesicle and the first terminal of the power supply, each connection including a switch so as to allow the metallic portion to function as an anode when the switch is closed; and (d) A cathode formed from a second metal attached to the second terminal of the power supply; wherein the cathode is separated from the anodes by a space that is assessable by the electrolytic fluid when the device is in the body cavity.”

Rejection of claims 1-6 and 12-16

With respect to the Examiner’s assertions of the Microchips, Inc. ‘401 publication disclosing “a medical device (Fig. 2) for controlled release of one or more substances... into a body cavity... containing an electrolytic fluid...comprising...” while Applicants agree that the Microchips, Inc. ‘401 publication discloses a (microchip) device for release of one or more substances (reservoir contents) in any electroconductive (preferably biocompatible) fluid, as disclosed on page 4, paragraph 4 of the Microchips, Inc. ‘401 publication, Applicants respectfully disagree with the Examiner’s further interpretations, and submit that several significant features of the instant claims are not disclosed or taught in the Microchips, Inc. ‘401 publication.

On page 2 of the outstanding Office Action, the Examiner refers to Fig. 2 of the Microchips, Inc. ‘401 publication in asserting that the reservoir 58 is a “blister-like vesicle” because the cap 60 protrudes above the surface of the substrate 56. However, according to the on-line Merriam Webster dictionary (<http://www.merriam-webster.com/dictionary> accessed

September 11, 2008), a blister is “an elevation of the epidermis containing watery liquid” (<http://www.merriam-webster.com/dictionary/blister>) and a vesicle is “a small abnormal elevation of the outer layer of skin enclosing a watery liquid” (<http://www.merriam-webster.com/dictionary/vesicle>). That is, the definitions of both “blister” and “vesicle” require that the watery liquid be contained in the elevation. As seen in Fig. 2 of the Microchips, Inc. ‘401 publication, the contents of the reservoir 58 are contained below the exposed surface of the substrate 56. Therefore, the Examiner’s assertion that the reservoir 58 can be considered to be a “blister-like vesicle”, merely because the cap 60 is above the surface of the substrate 56, does not appear to be justified when compared against the accepted definition of such terms.

Furthermore, the Examiner’s assertion that the reservoir 58 is “mounted on a first surface” (modeled after the recitation in Applicants’ claim 1) also does not appear to be justified since only the cap 60, and not the *entire* reservoir, is located above the surface of the substrate. Applicants assume that the Examiner has identified the surface of the substrate 60 as the “first surface” of claim 1 of the application since the Examiner states that the caps “protrude from the surface [of the substrate 56].”

For at least these reasons, the § 102(e) rejections in view of the Microchips, Inc. ‘401 publication do not appear to be justified and should be reconsidered. Nonetheless, if necessary, Applicants are agreeable to amending claim 1 to recite that the blister-like vesicles enclose an interior that is elevated above the first surface.

Finally, the Microchips, Inc. ‘401 publication states on page 8, lines 11-12 that “[e]ach microchip includes a substrate having a plurality of reservoirs” but only discloses a plurality of reservoirs in the context of “as described, for example, in U.S. Patent 5,797,898 to Santini, et al.” Indeed, Figs. 1 and 2 of the Microchips, Inc. ‘401 publication both show a single reservoir (elements 18 and 58, respectively), and not “a plurality of blister-like vesicles mounted on a first surface...” as recited in part (b) of Applicants’ claim 1. Neither the Microchips, Inc. ‘401 publication nor US Patent No. 5,797,898 to Santini et al. (cited in the Microchips, Inc. ‘401 publication extract) discloses “for each vesicle, an electrical connection between the metallic portion of the vesicle and the first terminal of the power supply...” as recited in part (c) of Applicants’ claim 1, i.e. that each reservoir is connected to the power source by an individual electrical connection. It is then clear that neither the Microchips, Inc. ‘401 publication or the Santini ‘898 patent recites or would be able to comprise “for each vesicle, an electrical

connection ... each connection including a switch so as to allow the metallic portion to function as an anode when the switch is closed” as further recited in part (c) of Applicants’ claim 1. In fact, contrary to that asserted in the outstanding Office Action, the Microchips, Inc. ‘401 publication nowhere mentions the word “switch.” Applicants note that connecting each vesicle with an individual switch allows control of the release of substances from the vesicles, so that release can be made to occur sequentially from the vesicles over time (each vesicle releases its contents at a different time). This is nowhere disclosed in the Microchips, Inc. ‘401 publication.

Applicants’ original claim 2 recites: “The device according to claim 1 further comprising a processor configured to close one or more switches at one or more predetermined times.”

With regard to claim 2, the Examiner references the word “microprocessor” on page 8, line 34 of the Microchips, Inc. ‘401 publication. However, the microprocessor referred to here is a microprocessor used to measure signals from a biosensor associated with the device. Since the Microchips, Inc. ‘401 publication nowhere mentions a plurality of switches, the Microchips, Inc. ‘401 publication clearly is incapable of disclosing “a processor configured to close one or more switches at one or more predetermined times” as recited in Applicants’ claim 2.

Applicants’ original claim 4 recites: “The device according to claim 1 wherein the switches are closed by means of a remote control.”

With regard to claim 4, since the Microchips, Inc. ‘401 publication nowhere mentions a plurality of switches, the Microchips, Inc. ‘401 publication obviously is incapable of disclosing and nowhere mentions a device “wherein the switches are closed by means of a remote control” as recited in Applicants’ claim 4.

Therefore, as none of the cited prior art has disclosed the above discussed features of the claims, Applicants respectfully submit that features of claims 1, 2 and 4 discussed above are patentable over the Microchips, Inc. ‘401 publication. Therefore, such claims are novel and therefore patentable over the cited prior art (the Microchips, Inc. ‘401 publication), an indication of which is kindly requested. Dependent claims 2-6 and 12-16 depend from independent claim 1. Thus, Applicants submit that dependent claims 2 and 4 are also patentable by virtue of their dependency and dependent claims 3, 5, 6 and 12-16 are patentable at least by virtue of their dependency.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 7-11 and 17-28 under 35 U.S.C. § 103(a), as being unpatentable over the Microchips, Inc. '401 publication in view of the Yachia et al. '923 patent.

Response

Applicants respectfully traverse the rejections since all of the features of the presently claimed subject matter are not disclosed by the cited references.

Applicants respectfully submit that the Yachia et al. '923 patent fails to cure the deficiencies of the Microchips, Inc. '401 publication with respect to the subject matter in accordance with Applicants' original claim 1 and further, does not suggest a teaching or motivation to reach such subject matter as claimed in the instant application.

Therefore, Applicants believe that original claim 1 is novel and unobvious and therefore patentable with reference to the cited prior art of record and respectfully request an indication of such.

As Applicants have demonstrated that original claim 1 is novel, unobvious and consequently patentable, claims 7-11 and 17-28 are also novel, unobvious and consequently patentable against the cited prior art by virtue of their direct or indirect dependency from claim 1. No *prima facie* rejection under 35 U.S.C. 103(a) can be made against these claims and Applicants request an indication of such.

In view of the foregoing, reconsideration and withdrawal of the above rejections is respectfully requested.

CONCLUSION

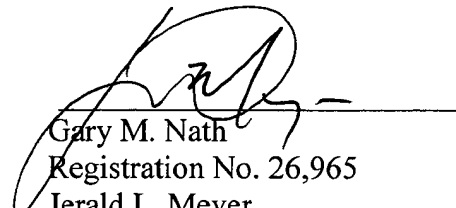
In light of the foregoing, Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner call the undersigned attorney(s).

Respectfully submitted,

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